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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/511,362	02/23/2000	Kevin Sullivan	47004.000067	4127
21967	7590	11/03/2004	EXAMINER	
HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109			BASHORE, ALAIN L	
		ART UNIT		PAPER NUMBER
		3624		
DATE MAILED: 11/03/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/511,362	SULLIVAN, KEVIN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alain L. Bashore	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 June 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 14-15, 29-54 and 56-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 14-15, 29-32, 34-54, and 56-59 is/are rejected.
- 7) Claim(s) 33 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____ .  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>one page</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 47 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "incentivize" is considered a relative term. What is incentive to one may not be incentive to another.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 14-15, 29-32, 34-35, 37, 39-44, 47-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez-Holtsmann in view of Feidelson et al in further view of Walker et al (458).

Fernandez-Holtsmann discloses establishing a credit card account as a card payment instrument account having a rebate feature, establishing an investment account (inherently including "activation" per se) for the benefit of the approved cardholder (col 4, lines 45-46), calculating a rebate as a percentage of the net purchases periodically as a percentage of net-purchases, and funding the investment account with the rebate (col 5, lines 48-67; col 6, lines 1-20). A statement is issued (fig 5). Separate institutions are disclosed for the credit card and investment account (col 2, lines 28-33). The investment account may be an existing account (col 4, lines 45-51). Fernandez-Holtsmann also discloses funding the rebate as shared with the credit card account provider providing the credit card account (col 4, lines 20-34).

Since the method to Fernandez-Holtsmann discloses step S2 occurring after step S1 (see fig 1) there is discloses a "new" investment account established as a result of the credit card account provider to set-up the new account fund account for the benefit of the approved cardholder.

Fernandez-Holtsmann does not disclose:  
the statement including an offer to activate an investment fund account to be funded with the rebate and the acceptance of the offer;  
rebates accrue (as aggregated) according to a first period (monthly), and wherein the rebate can vest to be applied to the investment account according to a second period; and,

issuing a statement to the cardholder including calculated rebate, rebate value applied to the investment account.

Feidelson et al discloses rebates accrue (as aggregated) according to a first period (monthly), and wherein the rebate can vest to be applied to the investment account according to a second period (col 11, lines 31-44), and issuing statements to the cardholder (col 12, lines 54-64).

It would have been obvious to one with ordinary skill in the art to include to Fernandez-Holtsmann rebates accrue according to a first period (monthly), and wherein the rebate can vest to be applied to the investment account according to a second period for administrative purposes (i.e. minimums required) as taught by Feidelson et al (col 9, lines 64-67; col 10, lines 1-2; col 11, lines 31-44).

It would have been obvious to one with ordinary skill in the art to include to Fernandez-Holtsmann issuing statements to the cardholder including calculated rebate, rebate value applied to the investment account, accrued rebate value not yet vested to be applied to the investment account all because Feidelson et al teaches information dissemination (col 12, lines 54-67).

Walker et al (458) discloses a statement including an offer to activate an offer to be funded with the rebate and the acceptance of the offer (col 2, lines 45-67; col 3, lines 1-20).

It would have been obvious to one with ordinary skill in the art to include a statement including an offer to activate an investment fund account to be funded with the rebate and the acceptance of the offer because Walker et al teaches added offers on a billing statement may result in added consumer activity (col 1, lines 54-56).

5. Claims 36, 46, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez-Holtsmann in view of Feidelson et al in further view of Walker et al (458) as applied to claims above, and further in view of Chen.

Chen discloses percentage as variable based on cardholder loyalty (col 9, lines 4-40).

It would have been obvious to one with ordinary skill in the art to include the percentage as variable based on cardholder loyalty because Chen teaches variability present for loyalty because of incrementation (col 9, lines 35-38).

6. Claims 35, 45, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez-Holtsmann in view of Feidelson et al in further view of Walker et al (458) as applied to claims above, and further in view of Simpson.

Simpson discloses funding the rebate as shared with the investment account provider (col 3, lines 20-25).

It would have been obvious to one with ordinary skill in the art to include funding the rebate as shared with the investment account provider because Simpson teaches costs associated with investment account initial startup (col 3, lines 20-25).

7. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez-Holtsmann in view of Feidelson et al in further view of Walker et al (458) as applied to claims above, and further in view of Kalina (688).

Kalina discloses "automatic" establishment of a new investment account (col 1, lines 15-20; col 6, lines 20-25).

It would have been obvious to one with ordinary skill in the art to automate establishment of the new investment account upon acceptance of the offer for purposes of convenience and in view of In re Venner et al (120 USPQ 192) that teaches that automatic provision is not patentably distinct.

***Allowable Subject Matter***

8. Claim 33 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Allowable subject matter requires a second level review for applications in class 705 before a notice of allowance is mailed to applicant.

***Response to Arguments***

9. Applicant's arguments filed 6-23-04 have been fully considered but they are not persuasive.

The Walker reference is utilized to provide a teaching for utilizing a statement. Activating the investment fund and its establishment is found inherently in the primary reference.

Regarding Feidelson et al, there appears to be taught vesting since account over a specified amount is determined for payment.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 703-308-1884. The examiner can normally be reached on about 7:00 am to 4:30 pm (Monday thru Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alain L. Bashore  
Primary Examiner  
Art Unit 3624